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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,585	05/28/1999	JOSH KELMAN	P-2590-1/TAC	8229

7590 12/02/2002
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EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

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DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/322,585

Applicant(s)

KELMAN ET AL.

Examiner

EDMUND H LEE

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-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/02 has been entered.

2. Claims 1 and 3-18 are pending. Claims 12-18, however, have been withdrawn because they are directed to a non-elected invention.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth on pg 1-3 of the instant specification in view of Reid et al (USPN 5810406). In regard to independent claim 1, the admitted prior art teaches assembling interior trim parts in which a first trim part is disposed adjacent a second trim part and in which a bead of buffer material/elastomer is provided between the first and second trim parts to reduce noises which are caused by the contact and relative movement between the edge surfaces of the trim parts; providing a first trim part having a peripheral mating edge configured to lie alongside a peripheral mating edge of the second trim part when the first and second trim parts are disposed adjacent one

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another in a vehicle--as a note, this teaching and the example of trim panels set forth on pg 1 illustrate adjacent peripheral edges; extruding/providing a buffer material/elastomer on the mating edge of the first trim part such that the buffer material when hardened can absorb the contact and relative movements of the trim parts to reduce noises--as a note, this also illustrates the compression of the buffer material while between the trim parts; and allowing the bead to cure/harden before assembly of the trim parts. The admitted prior art also teaches that there is a problem with adhering elastomers to all the materials used to form automotive trim components and panels. However, the admitted prior art does not teach forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part; providing buffer material in the recess so as to provide a bead of buffer material on the mating surface; and allowing the bead to mechanically connect to the first trim part. Reid et al teach extruding a first layer of an automotive trim part (figs 2-3); feeding the first layer into a shaping die such that the first layer has a recess with an undercut portion therein; using a mechanical bond as opposed to adhesive tapes to mate two materials to form an automotive trim (col 1, lns 10-25 and 42-50; col 2, ln 55-col 3, ln 15; figs 2-3); and providing an inner layer with a recesses which are filled and overfilled with the material of the outer layer to create a mechanical bond between the two layers (col 2, ln 55-col 3, ln 15; figs 2-3). The admitted prior art and Reid et al are combinable because they are analogous with respect to a desire to form a stronger bond between mating materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the above teachings of Reid et al to the admitted prior

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art in order to securely fix the buffer material of the admitted prior art, i.e., buffer material that is on the mating surface of a trim part, to the trim part.

In regard to claims 3-11, the admitted prior art also teaches using a robotically controlled applicator/extruder to provide the buffer material/elastomer to the mating edge of the first trim part--as a note, it is inherent that the applicator/extruder has an extrusion head and the buffer material extrudes through the extrusion head; using an elastomeric material as the buffer material; and allowing the elastomer to cure--as a note, this constitutes that the elastomer is either a thermoplastic or thermosetting elastomer. However, the admitted prior art does not teach selecting thermoplastic urethane as the buffer material; the limitations of claim 7; the limitations of claims 8-9; providing a router having a router bit; and the specific design claimed in claim 11. In regard to selecting thermoplastic urethane as the buffer material, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed method since it is not a manipulative feature or step of the claimed method. Further, the claimed material is notoriously well-known in the molding for its moldability thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed material as the buffer material of the admitted prior art in order to enhance the bond between the trim parts. In regard to the limitations of claim 7, the above combination of the admitted prior art in view of Reid et al teach using a robotically controlled extruder/applicator that is connected to a source of fluid buffer material/elastomer to provide a bead of buffer material/elastomer in the recesses of the

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admitted prior art (modified) and on the mating edge of the admitted prior art (modified). In regard to the limitations of claims 8-9, it is well-known in the molding art to use a recess-forming tool such as a router to form recesses in a preform and to robotically control the recess-forming tool for better control. Further, it is well-known in the molding art to combine shaping and molding operations such as cutting and extruding in order to reduce cycle time and complexity. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the robotically controlled applicator of the admitted prior art to include a recess-forming tool before the applicator in order to achieve the above results. In regard to providing a router having a router bit, such is a mere obvious matter of choice dependent on the equipment availability and of little patentable consequence to the claimed method since it is not a manipulative feature or step of the claimed method. Further, the use of a router with a router bit to form recesses is notoriously well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a router with a router bit to form the recesses of the admitted prior art (modified) in order to reduce the complexity of the method. In regard to the specific design claimed in claim 11, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed method since it is not a manipulative feature or of the claimed method. Further, it is well-known in the molding art to apply a buffer material to a first trim that surrounds the second trim and then assembling the trim parts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the first trim part of the admitted

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prior art to be the trim part that surrounds the second trim part thereby facilitating the mating and bonding of the trim parts of the admitted prior art (modified).

5. Applicant's arguments filed 10/17/02 have been fully considered but they are not persuasive. Applicant argues that Reid "is not directed at reducing relative movement and resultant noise by adding a buffer bead in a recess between interior trim components at their peripheral edges" and does not teach compressing the bead between the first and second trim parts. It is true that Reid is not directed to the reducing movement and noise by adding a buffer material to a peripheral edge, and compressing the bead the between the trim parts; however, such limitations are taught by the admitted prior art as set forth in the instant application at pgs 1-3. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant is also reminded that Reid et al is applied to obviate the use of a mechanical bond over an adhesive bond. Specifically, Reid et al teach molding a first layer having a groove therein and then applying a second material in the grooves to securely fix the two materials together. Reid et al addresses the problem with the prior art as presented by Applicant in the instant specification.

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Edmund Lee whose telephone number is (703)305-4019. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 4:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703)308-3829. The fax phone number for this Group is (703)305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.

EHL

November 27, 2002


Edmund Lee 11/27/02
Patent Examiner, AU 1732